

OTPE JC98  
NOV 0 1 2004

2623  
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PTO/SB/21 (05-03)

Approved for use through 04/30/2003. OMB 0651-0031

U.S. Patent and Trademark Office: U.S. DEPARTMENT OF COMMERCE

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# TRANSMITTAL FORM

(to be used for all correspondence after initial filing)

Application Number	09/384,141
Filing Date	08/27/1999
First Named Inventor	Ikko Fushiki et al.
Art Unit	2623
Examiner Name	LaRose, C.
Attorney Docket Number	003797.81834

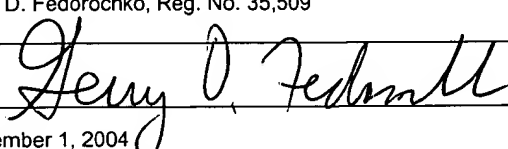
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Total Number of Pages in This Submission

## ENCLOSURES (check all that apply)

<input checked="" type="checkbox"/> Fee Transmittal Form  <input type="checkbox"/> Fee Attached  <input checked="" type="checkbox"/> Response To Request For Information Under 37 C.F.R. § 1.105, along with Exhibits 1 to 13  <input type="checkbox"/> After Final  <input type="checkbox"/> Affidavits/declaration(s)  <input checked="" type="checkbox"/> Extension of Time Request  <input type="checkbox"/> Express Abandonment Request  <input type="checkbox"/> Information Disclosure Statement  <input type="checkbox"/> Certified Copy of Priority Document(s)  <input type="checkbox"/> Response to Missing Parts/ Incomplete Application  <input type="checkbox"/> Response to Missing Parts under 37 CFR 1.52 or 1.53	<input type="checkbox"/> Assignment Papers (for an Application)  <input type="checkbox"/> Drawing(s)  <input type="checkbox"/> Licensing-related Papers  <input type="checkbox"/> Petition  <input type="checkbox"/> Petition to Convert to a Provisional Application  <input type="checkbox"/> Power of Attorney, Revocation Change of Correspondence Address  <input type="checkbox"/> Terminal Disclaimer  <input type="checkbox"/> Request for Refund  <input type="checkbox"/> CD, Number of CD(s) _____	<input type="checkbox"/> After Allowance Communication to Group  <input type="checkbox"/> Appeal Communication to Board of Appeals and Interferences  <input type="checkbox"/> Appeal Communication to Group (Appeal Notice, Brief, Reply Brief)  <input type="checkbox"/> Proprietary Information  <input type="checkbox"/> Status Letter  <input type="checkbox"/> Other Enclosure(s) (please identify below):
<div>Remarks</div>		

## SIGNATURE OF APPLICANT, ATTORNEY, OR AGENT

Firm or Individual name	Gary D. Fedorochko, Reg. No. 35,509
Signature	
Date	November 1, 2004

## CERTIFICATE OF MAILING

I hereby certify that this correspondence is being facsimile transmitted to the USPTO or deposited with the United States Postal Service with sufficient postage as first class mail in an envelope addressed to: Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450 on the date shown below.

Typed or printed name			
Signature		Date	

This collection of information is required by 37 CFR 1.5. The information is required to obtain or retain a benefit by the public which is to file (and by the USPTO to process) an application. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.14. This collection is estimated to 12 minutes to complete, including gathering, preparing, and submitting the completed application form to the USPTO. Time will vary depending upon the individual case. Any comments on the amount of time you require to complete this form and/or suggestions for reducing this burden, should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, U.S. Department of Commerce, P.O. Box 1450, Alexandria, VA 22313-1450. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. SEND TO: Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.



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**FEE TRANSMITTAL  
for FY 2005**

Effective 10/01/2004. Patent fees are subject to annual revision.

☐ Applicant claims small entity status. See 37 CFR 1.27

TOTAL AMOUNT OF PAYMENT (\$ ) 980.00

Complete If Known

Application Number 09/384,141

Filing Date 08/27/1999

First Named Inventor Ikko FUSHIKI et al.

Examiner Name LaRose, C.

Art Unit 2623

Attorney Docket No. 003797.81834

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Technology Center 2600

## METHOD OF PAYMENT (check all that apply)

☐ Check ☐ Credit card ☐ Money Order ☐ Other ☐ None☒ Deposit Account:Deposit  
Account  
Number

19-0733

Deposit  
Account  
Name

Banner &amp; Witcoff, LTD.

The Director is authorized to: (check all that apply)

☒ Charge fee(s) indicated below ☒ Credit any overpayments  
☒ Charge any additional fee(s) or any underpayment of fee(s)  
☐ Charge fee(s) indicated below, except for the filing fee  
to the above-identified deposit account.

## FEE CALCULATION

## 1. BASIC FILING FEE

Large Entity		Small Entity		Fee Description	Fee Paid
Fee Code	Fee (\$)	Fee Code	Fee (\$)		
1001	790	2001	395	Utility filing fee	
1002	350	2002	175	Design filing fee	
1003	550	2003	275	Plant filing fee	
1004	790	2004	395	Reissue filing fee	
1005	160	2005	80	Provisional filing fee	

SUBTOTAL (1)

(\$ ) 0

## 2. EXTRA CLAIM FEES FOR UTILITY AND REISSUE

Total Claims		Extra Claims		Fee from below		Fee Paid
	-20 **	= 0	X			0
Independent Claims						
	-3 **	= 0	X			0
Multiple Dependent						
			X			0

Large Entity		Small Entity		Fee Description
Fee Code	Fee (\$)	Fee Code	Fee (\$)	
1202	18	2202	9	Claims in excess of 20
1201	88	2201	44	Independent claims in excess of 3
1203	300	2203	150	Multiple dependent claim, if not paid
1204	88	2204	44	** Reissue independent claims over original patent
1205	18	2205	9	** Reissue claims in excess of 20 and over original patent

SUBTOTAL (2)

(\$ ) 0

\*\*or number previously paid, if greater; For Reissues, see above

## FEE CALCULATION (continued)

## 3. ADDITIONAL FEES

Large Entity		Small Entity		Fee Description	Fee Paid
Fee Code	Fee (\$)	Fee Code	Fee (\$)		
1051	130	2051	65	Surcharge - late filing fee or oath	
1052	50	2052	25	Surcharge - late provisional filing fee or cover sheet	
1053	130	1053	130	Non-English specification	
1812	2,520	1812	2,520	For filing a request for <i>ex parte</i> reexamination	
1804	920*	1804	920*	Requesting publication of SIR prior to Examiner action	
1805	1,840*	1805	1,840*	Requesting publication of SIR after Examiner action	
1251	110	2251	55	Extension for reply within first month	
1252	430	2252	215	Extension for reply within second month	
1253	980	2253	490	Extension for reply within third month	980
1254	1,530	2254	765	Extension for reply within fourth month	
1255	2,080	2255	1,040	Extension for reply within fifth month	
1401	340	2401	170	Notice of Appeal	
1402	340	2402	170	Filing a brief in support of an appeal	
1403	300	2403	150	Request for oral hearing	
1451	1,510	1451	1,510	Petition to institute a public use proceeding	
1452	110	2452	55	Petition to revive - unavoidable	
1453	1,370	2453	685	Petition to revive - unintentional	
1501	1,370	2501	685	Utility issue fee (or reissue)	
1502	490	2502	245	Design issue fee	
1503	660	2503	330	Plant issue fee	
1460	130	1460	130	Petitions to the Commissioner	
1807	50	1807	50	Processing fee under 37 CFR 1.17 (q)	
1806	180	1806	180	Submission of Information Disclosure Stmt	
8021	40	8021	40	Recording each patent assignment per property (times number of properties)	
1809	790	2809	395	Filing a submission after final rejection (37 CFR § 1.129(a))	
1810	790	2810	395	For each additional invention to be examined (37 CFR § 1.129(b))	
1801	790	2801	395	Request for Continued Examination (RCE)	
1802	900	1802	900	Request for expedited examination of a design application	

Other fee (specify) \_\_\_\_\_

\*Reduced by Basic Filing Fee Paid

SUBTOTAL (3)

(\$ ) 980

## SUBMITTED BY

Complete (if applicable)

Name (Print/Type)

Gary D. Fedorochko

Registration No. (Attorney/Agent)

35,509

Telephone

(202) 824-3000

Signature

Gary D. Fedorochko

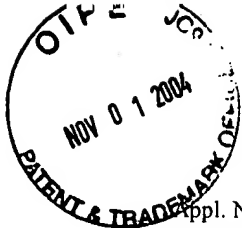
Date

November 1, 2004

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This collection of information is required by 37 CFR 1.17 and 1.27. The information is required to obtain or retain a benefit by the public which is to file (and by the USPTO to process) an application. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.14. This collection is estimated to take 12 minutes to complete, including gathering, preparing, and submitting the completed application form to the USPTO. Time will vary depending upon the individual case. Any comments on the amount of time you require to complete this form and/or suggestions for reducing this burden, should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, U.S. Department of Commerce, P.O. Box 1450, Alexandria, VA 22313-1450. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. SEND TO: Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.

If you need assistance in completing this form, call 1-800-PTO-9199 (1-800-786-9199) and select option 2.



Appl. No. 09/384,141  
Response Dated November 1, 2004  
Reply to Request for Information Under 37 C.F.R. § 1.105 of June 1, 2004

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Technology Center 2600

Appl. No. : 09/384,141  
Applicant : Ikko FUSHIKI et al.  
Filed : August 27, 1999  
Title : Visually Error-Free Color Image Representation  
  
TC/A.U. : 2623  
Examiner : LaRose, C.  
  
Docket No. : 003797.81834  
Confirmation No. : 7425

Commissioner for Patents  
P.O. Box 1450  
Alexandria, VA 22313-1450

**RESPONSE TO REQUEST FOR INFORMATION UNDER 37 C.F.R. § 1.105**

Sir:

In response to the Request for Information Under 37 C.F.R. § 1.105 mailed on June 1, 2004, please consider as follows:

**Response** begins on page 2 of this paper.

**Exhibits** begin on page 8 of this paper.

## **RESPONSE**

The Request for Information under 37 C.F.R. § 1.105 (hereinafter referred to as the "Request") of June 1, 2004, has been carefully reviewed and these remarks are responsive thereto. Applicants have listed the three (3) issues of the Request from paragraph 3, in addition to the Requests from paragraphs 4-8, with responses for each issue and/or Request provided thereafter.

3. The information is required to document the level of skill and knowledge in the art pertaining to the expanded sRGB color space. Specifically, the information should address the following issues:

**a. When was the sRGB64 color space or the concept of an expanded sRGB color space first developed or created? Was the sRGB64 color space or the concept of an expanded sRGB color space described at a conference, published, or otherwise publicly known before 27 August 1999?**

The inventors of the present application began development of the sRGB64 color space at least as early as February 1999. Evidence of the development can be found in Exhibits 1-5 attached herein. Although Applicants do not admit that the documents identified in Exhibits 1-5 are "non-patent publications" as required for response under 37 C.F.R. § 1.105 and without acquiescing to this point, Applicants submit these documents in order to help the Examiner extend the domain of search for prior art. The dates of documents in Exhibits 1-4 have been redacted.

Exhibit 1 is an internal, confidential, and non-publicly available email string between two of the inventors, Ikko Fushiki and Gary Starkweather, discussing the gamut expanded sRGB color space. Exhibit 2 is an internal, confidential, and non-publicly disclosed document written by inventor Ikko Fushiki describing the XsRGB color space. Exhibit 3 is an internal,

confidential, and non-publicly disclosed patent predisclosure document written by inventor Ikko Fushiki describing the XsRGB color space. Exhibit 4 is another internal, confidential, and non-publicly disclosed document written by inventor Ikko Fushiki describing the XsRGB color space.

Exhibit 5 is the first working draft (7-22-98) of IEC 61966-2-2: 'Colour Measurement and Management in Multimedia Systems and Equipment-Part 2-2: Extended Precision RGB Colour Space' (hereinafter referred to as *IEC 61966-2-2 working draft*). *IEC 61966-2-2 working draft* describes the first working draft as developed by the 61966 Project Team, co-project leader Mr. Michael Stokes. Specifically, equation (4) on page 5 describes a gamma value conversion that utilizes an exponent of 2.4. This exponent value of 2.4 defines the color space described in the working draft as a non-linear color space.

**b. Who created the sRGB64 color space or the concept of an expanded sRGB color space? If an organization developed it, what individuals were involved in its development?**

The sRGB64 color space was conceived of and reduced to practice by the inventors of the present invention. All of the inventors of the present invention were employed by and assigned rights to Microsoft Corporation. The inventors of the present invention sought to improve upon the color space described in the *IEC 61966-2-2 working draft*. During development of the standard that became IEC 61966-2-2, the inventors of the present application proposed the features of the present invention to the 61966 Project Team, co-project leader Mr. Michael Stokes.

Page 5 of Exhibit 3 describes some of the meetings and discussions between Mr. Ikko Fushiki (inventor) and Mr. Michael Stokes, co-project leader of 61966 Project Team. On May 21, 1999, Applicants filed U.S. Provisional Application No. 60/135,361 to which the present application claims priority.

**c. Other than the first working draft of IEC 61966-2-2 (dated 22 July 1998), is the Applicant aware of or in possession of any documents, letters, internal memos, draft specifications, or the like that were created and privately circulated before 27 August 1999, and that describe the sRGB64 color space or an expanded sRGB color space?**

Initially, Applicants do not admit that *IEC 61966-2-2 working draft* describes the sRGB64 color space and/or an expanded sRGB color space as in the present invention. Again, Applicants do not admit that the documents identified in Exhibits 1-5 are “non-patent publications” as required for response under 37 C.F.R. § 1.105. However, without acquiescing to this point, Applicants submit these documents in order to help the Examiner extend the domain of search for prior art.

Exhibits 1-5 describe the documents Applicants were aware of or in possession that were created and privately circulated before August 27, 1999. Any circulation of information occurred under one or more non-disclosure agreements with third parties.

**4. In response to this requirement, please provide copies of each publication which any of the applicants authored or co-authored and which describe the disclosed subject matter of sRGB64 or an expanded sRGB color space.**

Exhibits 1-4, as described above with reference to responding to paragraph 3, were authored by at least one inventor of the present application. Exhibit 6 is a copy of U.S. Provisional Application No. 60/135,361, to which the present application claims priority. In addition, two U.S. Patents were filed by some of the inventors common to the present invention. Exhibit 7 is a copy of U.S. Patent No. 6,462,748, authored by common inventors Fushiki, Godfrey, Goosen, and Lee. Exhibit 8 is a copy of U.S. Patent No. 6,748,107, authored by common inventors Fushiki, Lee, Goosen, and Starkweather. Each of Exhibits 1-4 and 6-8 describe the sRGB64 color space.

**5. In response to this requirement, please provide the title, citation and copy of each publication that any of the applicants relied upon to develop the disclosed subject matter that describes the applicant's invention, particularly as to developing sRGB64 or an expanded sRGB color space. For each publication, please provide a concise explanation of the reliance placed on that publication in the development of the disclosed subject matter.**

Exhibits 1-5, as described above with reference to responding to paragraph 3, were relied upon to develop the disclosed subject matter of the present application. In addition, U.S. Patent No. 5,224,178 was relied upon to develop the disclosed subject matter. Exhibit 9 is a copy of U.S. Patent No. 5,224,178. In particular, reference is made to U.S. Patent No. 5,224,178 in the background of the invention section of Applicants' original written description on page 2, line 8. U.S. Patent No. 5,224,178 describes one method for data conversion by compression digital code values to provide a set of reduced range digital codes of a same resolution, but having a smaller range of basic image content values than the dynamic range of the digitized image database.

**6. In response to this requirement, please provide the title, citation and copy of each publication that any of the applicants relied upon to draft the claimed subject matter. For each publication, please provide a concise explanation of the reliance placed on that publication in distinguishing the disclosed subject matter from the prior art.**

Exhibits 1-5, as described above with reference to responding to paragraph 3, and Exhibit 9, as described above with reference to responding to paragraph 5, were relied upon to draft the claimed subject matter of the present application. In addition three other documents were relied upon to draft the claimed subject matter.

Exhibit 10 is a copy of U.S. Patent No. 5,946,113. Exhibit 11 is a copy of a reference Stokes et al., entitled, "A Standard Default Color Space for the Internet – sRGB" (hereinafter referred to as *Stokes et al. reference*). Exhibit 12 is a copy of an Examiner Interview Summary dated October 7, 2003, and Exhibit 13 is a copy of the Declaration under 37 C.F.R. § 1.132 of Mr. Michael Stokes, dated November 12, 2003, that accompanied a response to an Office

Action. Specifically, during prosecution of the present application, Applicants responded to the combination of U.S. Patent No. 5,946,113 and the *Stokes et al. reference*. Applicants conducted an Examiner Interview on October 7, 2003 to discuss the use of the combination of references and responded by filing the Declaration of Mr. Stokes as described in Exhibit 13.

Applicants relied on the Declaration of Mr. Stokes to overcome the combination of references. Specifically, U.S. Patent No. 5,946,113 fails to teach or suggest conversion that utilizes a physical-based color space. Applicants rely on paragraphs 5-10 of the Declaration of Mr. Michael Stokes to support how U.S. Patent No. 5,946,113 fails to teach or suggest a physical-based color space conversion. The *Stokes et al. reference* further fails to cure the deficiencies of U.S. Patent No. 5,946,113.

**7. In response to this requirement, please state whether any search of prior art was performed. If a search was performed, please state the citation for each prior art collection searched. If any art retrieved from the search was considered material to demonstrating the knowledge of a person having ordinary skill in the art to the disclosed sRGB64 and/or an expanded sRGB color space, please provide the citation for each piece of art considered and a copy of the art.**

Applicants did not perform a search of prior art.

**8. In response to this requirement, please provide a list of citations to electronically searchable databases or other indexed collections containing publications that document the knowledge within the disclosed art of the sRGB64 color space or any expanded sRGB color spaces.**

Applicants are not aware of any electronically searchable databases or other indexed collections containing publications that document the knowledge within the disclosed art of the sRGB64 color space or any expanded sRGB color spaces.

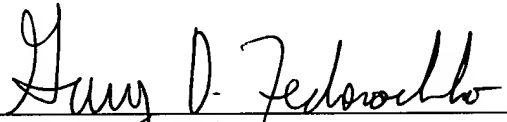


**CONCLUSION**

All requests having been addressed, Applicants respectfully submit that the instant application is in condition for allowance, and respectfully solicit prompt notification of the same. Should the Examiner find that a telephonic or personal interview would expedite passage to issue of the present application, the Examiner is encouraged to contact the undersigned attorney at the telephone number indicated below. No fee is believed due, however, if any fees are required or if an overpayment has been made the Commissioner is authorized to charge or credit Deposit Account No. 19-0733. Applicants look forward to passage to issue of the present application at the earliest convenience of the Office.

Respectfully submitted,  
**BANNER & WITCOFF, LTD.**

Date: November 1, 2004

By:   
Gary D. Fedorochko  
Registration No. 35,509

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